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OFFICE OF PETITIONS

In re Application of: : ON PETITION
Mosis. :
Filed: 30 July, 2001 :
Application No. 09/917,081 :
Docket No.: (None) :

This is a decision on the petition filed herein on 5 September, 2003, under 37 C.F.R. §1.137(a) to revive the above-identified application, and in light of the allegations (alleged timely receipt and agreement by an unidentified person at the Office to withdraw the holding of abandonment) considered as a petition to withdraw the holding of abandonment under 37 C.F.R. §1.181.

For the reasons set forth below, the petition:

- the petition as considered under 37 C.F.R. §1.181 to withdraw the holding of abandonment is **DISMISSED**; and
- under 37 C.F.R. §1.137(a) is **DISMISSED**.

NOTES:

- (1) Any petition (and fee) for reconsideration of this decision under 37 C.F.R. §1.137(a) (as to unavoidable delay) or an alternative request for relief under 37 C.F.R. §1.137(b)¹ (as to unintentional delay) must be submitted within two (2)

¹ Effective December 1, 1997, the provisions of 37 C.F.R. §1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 C.F.R. §1.137(b). a grantable petition filed under the provisions of 37 C.F.R. §1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 C.F.R. §1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c). (Emphasis supplied.)

months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(a)"; and/or "Petition under 37 C.F.R. §1.137(b)";

- (2) Thereafter, there will be no further reconsideration of this matter.

BACKGROUND

The record indicates that:

- Petitioner/Applicant Joseph K. Mosis (Petitioner) failed to reply timely and properly to the non-final Office action mailed on 9 April, 2002, and due (absent extension of time) on or before 9 July, 2002;
- the application was deemed abandoned after midnight 9 July, 2002;
- on 13 January, 2003, papers were filed via FAX by an individual identified as Gabrielle Tetreault, Esq., but who for whom there is neither a registration number listed with the Office nor a Power of Attorney executed by the Petitioner herein--and those papers were not entered;
- Notice of Abandonment was mailed on 24 June, 2003, and contained a discussion that the Petitioner herein might consider requesting the withdrawal of the holding of abandonment or alternatively petitioning to revive the application as having been abandoned due to unavoidable delay or unintentional delay;
- Petitioner filed the instant petition more than two months later, alleging, erroneously, that:
 - the Office agreed to withdraw the holding of abandonment (thus, reason for consideration under 37 C.F.R. §1.181); and
 - alternatively seeking revival of the application under 37 C.F.R. §1.137(a) because a reply was submitted, via Federal Express (Tracking No. 834671723937) on 5 July but not delivered until 12 July, 2002;
- a document styled "Response to Office Action Summary Dated April 9, 2002" was submitted in the 13 January, 2003, FAX materials, and Petitioner indicates this is the required reply.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).²

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.³

Delays in responding properly raise the question whether delays are unavoidable.⁴ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁵ And the Petitioner must be diligent in attending to the matter.⁶ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁷))

Allegations as to the Request to Withdraw the Holding of Abandonment and the Petition Alleging Unavoidable Delay

Petitioner contends that he submitted the reply timely via Federal Express, however, that courier

² 35 U.S.C. §133 provides:
35 U.S.C. §133 Time for prosecuting application.
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

³ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

⁴ See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁵ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁶ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

⁷ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

was not able to deliver the materials until 12 July, 2003--three days after the end of the shortened statutory period.

Because Petitioner alleges that the holding of abandonment was improper, the instant petition is considered in light of the regulations at 37 C.F.R. §1.181.

Petitioner could have submitted the required reply:

- via US Postal Service (USPS) first class mail or via FAX under the provisions of 37 C.F.R. §1.8 with a certificate of mailing via first class mail or certificate of FAX transmission, respectively; or
- via USPS Express Mail under the provisions of 37 C.F.R. §1.10 with a certificate of Express Mail identifying the submission with the Express Mail label number.

Petitioner chose none of those alternatives.

Applicants and practitioners who fail to use the rules and procedures set out by the Office to benefit their practice before it, not surprisingly also fail to gain those very benefits.

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.⁸

Petitioner has alleged but failed to evidence that the Office improperly deemed the instant application abandoned because the necessary reply was timely submitted under the rules and/or received, and thus fails to satisfy the requirements for having the holding of abandonment withdrawn.

A delay is not "unavoidable" when an applicant simply fails to file properly and timely the required reply and so permits the maximum extendable statutory period for reply to expire.⁹

In determining if a delay was unavoidable, decisions on reviving abandoned applications have adopted the standard of the reasonably prudent person acting in their most important business matters.¹⁰

⁸ See: Delgar v. Schulver, 172 USPQ 513 (D.D.C. 1971).

⁹ See MPEP 711.03(c)(III)(C)(2).

¹⁰ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."¹¹

Petitioner simply failed to file a timely and proper response to the non-final Office action.

Such practice clearly does not satisfy the Pratt requirements of diligence in attending to one's most important business affairs.

Therefore, Petitioner fails to satisfy the showing as required under 37 C.F.R. §1.137(a).

Accordingly, Petitioner has failed to establish to the satisfaction of the Commissioner that the delay was "unavoidable" within the meaning of 37 C.F.R. §1.137.¹²

It is noted that, as of this writing, it does not appear that the fee for the petition under 37 C.F.R. §1.137(a) was submitted with the petition (notwithstanding the contrary statement in the petition that a fee of "\$55" was submitted--this is erroneously set forth as an Issue Fee).

CONCLUSION

Because Petitioner failed to satisfy the burdens set forth in Delgar v. Schulyer, the petition under 37 C.F.R. §1.181 must be and hereby is **dismissed**.

Moreover, the circumstances of this application do not demonstrate as of this writing that the delay in filing the first petition was/is within the statutory and regulatory meaning of unavoidable delay--and the instant petition fails to satisfy the "showing" requirement as to relief sought and the "fee" requirement of the regulations.

Therefore, in the absence of those requirements, the petition herein 37 C.F.R. §1.137(a) must be and hereby is **dismissed**.

ALTERNATIVE VENUE

It appears that Petitioner is unable to make a showing of unavoidable delay surpassing that tendered heretofore, and, therefore, Petitioner's only alternative to irretrievable abandonment likely is to file a petition and fee as set forth at NOTE 1, above at page 2, under 37 C.F.R. §1.137(b), and state therein that "the entire delay in filing the required reply from the due date for

¹¹ Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

¹² See Application of G, 11 USPQ2d at 1380; In re Application of S, *Id.*

the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional.”

Thus, Petitioner may wish to supplement his petition to plead alternatively under 37 C.F.R. §1.137(b) wherein the "showing" burden is much less onerous.

Petitioner is cautioned that failure to submit such a petition 37 C.F.R. §1.137(b) timely may be viewed as intentional delay and an absolute bar to revival.

Further correspondence with respect to this matter should be addressed as follows:

By mail: (Effective 1 May, 2003)¹³
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (703) 308-6916
ATTN.: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



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¹³ To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.